

JUL 15 2005

PTO/SB/17 (12-04)
Approved for use through 07/31/2008, OMB 0651-0032
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

(Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.)

Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4518). FEE TRANSMITTAL For FY 2005		Complete if Known Application Number 09/751,436 Filing Date 12/29/2000 First Named Inventor Bassam A. Saliba Examiner Name Siegfried Chencinski Art Unit 3628 Attorney Docket No. MS1 -426USC1	
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27			
TOTAL AMOUNT OF PAYMENT (\$500.00)			

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☒ Deposit Account Deposit Account Number: 12-0769 Deposit Account Name: Lee & Hayes, PLLC

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee
☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2032.

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims - 20 or HP = _____ x 50 = _____
 HP = highest number of total claims paid for, if greater than 20
Indep. Claims - 3 or HP = _____ x 200 = _____
 HP = highest number of independent claims paid for, if greater than 3

Multiple Dependent Claims
 Fee (\$): _____ Fee Paid (\$): _____

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fees Paid (\$)
_____ - 100 = _____	_____ / 50 = _____	_____ (round up to a whole number)	_____ x _____ = _____	

4. OTHER FEE(S)

	Fees Paid (\$)
Non-English Specification, \$130 fee (no small entity discount)	
Other: Appeal Brief	
	\$500.00

SUBMITTED BY			
Signature		Registration No. 45313 (Attorney/Agent)	Telephone (509) 324-9256
Name (Print/Type)	William J. Breen, III	Date	7/15/05

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

RECEIVED
OIPENAP
JUL 18 2005

**RECEIVED
CENTRAL FAX CENTER**

JUL 15 2005 09:21 FR LEE - HAYES PLL

509 323 8979 TO 15712738300

P.01/40

JUL 15 2005

PTO/SB/21 (08-03)

Approved for use through 07/31/2006. OMB 0851-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

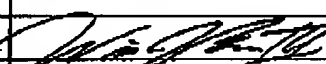
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/751,436	
	Filing Date	12/29/2000	
	First Named Inventor	Bassam A. Saliba	
	Group Art Unit	3628	
	Examiner Name	Siegfried E. Chencinski	
Total Number of Pages In This Submission	40	Attorney Docket Number	MS1-428USC1

ENCLOSURES (check all that apply)

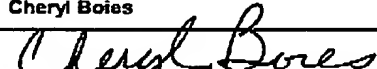
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Documents <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group <i>(Appeal Notice, Brief, Reply Brief)</i> <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) <i>(please identify below):</i> Brief of Appellant (38 pages)
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual Name	William J. Breen, III/Reg. No. 45313		
Signature			
Date	7/15/05		

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	Cheryl Boies		
Signature		Date	7-15-05

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

RECEIVED
CENTRAL FAX CENTER

JUL 15 2005

PATENT APPLICATION
Docket No. MS1-426USC1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)
	Saliba et al)
Serial No.:	09/751,436) Appeal No.
Confirmation No.	8755)
Filed:	December 29, 2000)
For:	System and Method for Secure Distribution Of Information via eMail)
Examiner:	Chencinski, S.)

The Honorable Commissioner of Patents
Mail Stop Appeal Brief - Patents
P.O. BOX 1450
Alexandria, VA 22313-1450

BRIEF OF APPELLANT

The Applicant has filed a timely Notice of Appeal from the action of the Examiner in finally rejecting all of the claims that were considered in this application. This Brief is being filed under the provisions of 37 C.F.R. § 1.192. The Filing Fee, as set forth in 37 C.F.R. § 1.17(c), is submitted herewith.

07/18/2005 CNGUYEN 00000051 120769 09751436

01 FC:1401 500.00 DA

TABLE OF CONTENTS

Real Party in Interest	Page 3
Related Appcals and Interferences	Page 4
Status of Claims	Page 5
Status of Amendments	Page 6
Summary of Invention	Page 7
Grounds of Rejection	Page 10
Argument	Page 11
Claims Appendix	Page 26

REAL PARTY IN INTEREST

The real party in interest is Microsoft Corporation, Inc. by way of assignment from Saliba et al., who is the named inventive entity and is captioned in the present brief.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF CLAIMS

Claims 1-59 are pending in the application and stand finally rejected by the Examiner.

STATUS OF AMENDMENTS

An amendment was filed subsequent to the Final Office Action mailed on January 27, 2005. However, the amendment was not entered by the Examiner.

SUMMARY OF INVENTION

Systems and methods are described for the secure distribution of information via email. According to an exemplary implementation described beginning at page 4 of the application, a method enabling users to conduct financial transactions using email is presented. According to one aspect of the invention, bill data is received at a server implementing the method. In response, the server generates an email message with information including at least a portion of the received bill data, wherein the amount of bill data included in the email message is based, at least in part, on the email address of the recipient. According to one embodiment, the server determines how secure the link to the recipient is from the email address. If the link is deemed secure (e.g., recipient is a participant), the email message will contain substantially all of the bill data. If, alternatively, the link is determined to be less than secure (e.g., the recipient is not a participant), the email message may only contain an address where a more secure communication session may be established to view the bill data. In this way, a server incorporating the teachings of the present invention enables a participant to conduct financial transactions with another, regardless of whether the recipient is a participant, via the email system. By facilitating electronic financial transactions between participants and non-participants, it will be appreciated from the discussion to follow that the present invention solves the aggregation problem typical of prior art electronic financial systems. *See Application, page 4.*

For example, in FIG. 1 Email system 102 is shown comprising a user interface 115

with an innovative financial transaction manager (FTM) 116, a storage device 118 including email system account information, and a storage device 120 to store and maintain transaction records. Although shown separately, the email system account information and the transaction records may well be stored and maintained in a single storage device, e.g., 118, and may be integrated into a common database.

Independent claim 1 recites "a method comprising: receiving bill data (e.g., page 4, lines 5-6); and generating an email message with information including at least a portion of the received bill data, wherein the amount of bill data included in the email message is based, at least in part, on an email address of a recipient (e.g., page 4, lines 8-15), and wherein the recipient can be either a user or a non-user of a secure email system (e.g., page 4, lines 15-21), wherein no non-user had registered for a service of the secure email system (e.g., pages 11-12).

Independent claim 11 recites "a data network comprising: a plurality of computing devices (e.g., 104(a), FIG. 1), coupled to the network (e.g., 112, FIG. 1), to facilitate network access by one or more participants; and an email server (e.g., 102, FIG. 1), coupled to the data network and responsive to one or more of the plurality of computing devices, the data server including: a storage medium (e.g., 118, FIG. 1) to store at least one financial account for each of the plurality of participants; and a financial transaction manager (e.g., 116, FIG. 1), coupled to the memory device and selectively invoked by a participant, to manage access to and manipulation of financial account assets to effect requested financial transactions with

any network participant or non-participant, wherein no non-participants have registered for a service of an email system supported by the email server.

Independent claim 37 recites "An email system, selectively accessed by users on a data network using a computing device, the email system comprising: a user interface (e.g., FIG. 7), through which a user accesses an account associated with the user; one or more storage devices (e.g., 120, FIG. 1), to store and maintain account information for each of the users; and a financial transaction manager (e.g., 116, FIG. 1), responsive to the user interface and coupled to the one or more storage devices, to manage access to and control assets of user accounts in response to user interaction with the user interface to enable the user to conduct financial transactions with another user or non-user of the email system, wherein the non-user of the email system has not registered for a service of the email system.

GROUND OF REJECTION

1. Whether Claims 1-36 were properly rejected under 35 U.S.C. § 112, first paragraph as not supported by the specification.
2. Whether Claims 1, 2, 8, 10-19, 25, 28, 36, 37, 39, 40, 42 49 and 52 were properly rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,963,925 to Kolling et al. (hereinafter "Kolling").
3. Whether Claims 3, 4-6 and 9 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Kolling in view of U.S. Patent No. 6,721,783 to Blossman et al. (hereinafter "Blossman").
4. Whether Claim 7 was properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Kolling in view of of U.S. Patent 6,049,784 to Weatherly (hereinafter Weatherly).

ARGUMENT

First Ground of Rejection. Claims 1-36 satisfy the requirements of 35 U.S.C. § 112, first paragraph and therefore are allowable.

The Examiner asserts that the “limitation not supported is ‘no non-user has registered for a service of the secure e-mail system’”. *See Office Action Dated January 27, 2005, Page 2.* The Examiner then goes on to assert the following:

The specification does not restrict the recipients of billing e-mails to those who have registered for a service of the secure e-mail system. The specification merely reduces the content of billing information to those whose network or communications connection does not meet the sender system’s security parameters. Therefore this limitation segment is new matter. Claims 2-10 and 12-36 are rejected because of their dependency on claims 1 and 11, respectively. *Office Action Dated January 27, 2005, Page 2.*

It is respectfully submitted that the Examiner has misinterpreted the claims.

Claim 1 recites “wherein no non-user had registered for a service of the secure email system” and claim 11 recites “wherein no non-participants have registered for a service of an email system supported by the email server”. The specification, as filed, includes numerous instances which describe non-participants and non-users, portions of which are excerpted as follows:

Rather, financial transaction manager 116 only distinguishes between “users” and “non-users” of the email system 102, as this distinction will control whether the transaction may be carried out entirely electronically, or whether physical bills, checks, and the like will be required to complete the transaction. Thus, any user may, at a first time be a “biller” (i.e., request payment into an email system account), while at a second time be a “consumer” (i.e., purchase goods/services

utilizing an email system account). *Application, Page 11 (emphasis added)*.

Moreover, unlike the EBPP systems of the prior art, the financial transaction manager 116 enables a user to initiate financial transactions with non-users 126 of the system, according to one aspect of the present invention. Indeed, according to certain business models to be described more fully below, **financial transactions with non-users 126 may be tailored by the financial transaction manager 116 to include a special offer/invitation to establish an account on the email system 102 and "join" the service.** In this regard, the financial transaction manager 116 enables the email system 102 to better accommodate the myriad of financial transactions performed daily by consumers, small business and large corporations alike – i.e., the financial transaction manager 116 facilitates the implementation of a truly ubiquitous financial network 100. *Application, Pages 11-12 (emphasis added)*.

According to one embodiment, the server determines how secure the link to the recipient is from the email address. If the link is deemed secure (e.g., recipient is a participant), the email message will contain substantially all of the bill data. If, alternatively, the link is determined to be less than secure (e.g., the recipient is not a participant), the email message may only contain an address where a more secure communication session may be established to view the bill data. In this way, **a server incorporating the teachings of the present invention enables a participant to conduct financial transactions with another, regardless of whether the recipient is a participant, via the email system.** By facilitating electronic financial transactions between participants and non-participants, it will be appreciated from the discussion to follow that the present invention solves the aggregation problem typical of prior art electronic financial systems. *Application, Page 4 (emphasis added)*.

This invention concerns a system and method **facilitating personal electronic financial transactions with anyone, including non-users of the system and methods, via an email system.** *Application, Page 7 (emphasis added)*.

Fig. 1 illustrates an example network 100 including an email system 102 with an innovative financial transaction manager 116, which enables any user of the email system to conduct financial transactions with other users and non-users alike. *Application, Page 8.*

Thus, as shown in the above excerpted portions of the application, users and non-users, as well as participants and non-participants, are defined based on their relationship to the system, e.g., the email system. Non-participants may "join" the service, which thereby results in registration to the service. *See Application, Pages 11-12.* Accordingly, the features of claim 1 which recite "wherein no non-user had registered for a service of the secure email system" and the features of claim 11 which recite "wherein no non-participants have registered for a service of an email system supported by the email server" are supported by the specification. The Applicant respectfully requests the Board to overturn the First Ground of Rejection.

Second Ground of Rejection. Claims 1, 2, 8, 10-19, 25, 28, 36, 37, 39, 40, 42 49 and 52 satisfy the requirements of 35 U.S.C. § 102(e) and therefore are not anticipated by Kolling.

1. **Kolling Requires Consumers to Register for a Service**

Kolling describes an electronic statement presentment system. In relation to FIG. 8 of Kolling, an embodiment is described by which a consumer enrolls in an electronic statement presentment (ESP) system, which is described in Kolling as one technique by which a consumer may subscribe to the ESP service. An available subscription is equivalent to the identification of an in-service template, and a subscription may be viewed as a unique relationship between a template identifier and a customer's biller account number (CBAN). Once a subscription has been confirmed, a billing relationship is established between a consumer and a biller. *See Kolling, Col. 25, Lines 45-54.* The biller is also a participant in the Kolling system. *See Kolling, FIG. 2 and related discussion at Col. 7, Line 25 to Col. 8, Lines 35.* Thus, Kolling requires registration before a relationship is established.

2. **Applicant describes Transactions that may involve Users and Non-Users of a System**

Beginning at page 11 of the subject application, Applicant describes an exemplary embodiment in which, unlike the electronic bill presentment and payment (EBPP) systems of the prior art, the financial transaction manager 116 enables a user to initiate financial transactions with non-users 126 of the system, according to one

aspect of the present invention. Indeed, according to certain business models to be described more fully below, financial transactions with non-users 126 may be tailored by the financial transaction manager 116 to include a special offer/invitation to establish an account on the email system 102 and "join" the service. In this regard, the financial transaction manager 116 enables the email system 102 to better accommodate the myriad of financial transactions performed daily by consumers, small business and large corporations alike – i.e., the financial transaction manager 116 facilitates the implementation of a truly ubiquitous financial network 100. *Application, Pages 11-12 (emphasis added).*

3. **Claims 1, 2, 8, 10-19, 25, 28, 36, 37, 39, 40, 42 49 and 52 are Not Anticipated by Kolling**

As previously stated, Kolling's system requires consumers to, in effect, register for a service, e.g., in FIG. 8, block 708 of Kolling a "consumer requests electronic statement subscription for a biller". The Examiner asserted the following portions of Kolling in rejecting the recited features of Claim 1:

It is important for a biller to deliver an invoice to a consumer so that the consumer may then pay the bill presented in the invoice. *Kolling, Col. 3, Lines 14-16.*

Although the present invention may operate stand-alone, in one embodiment of the invention the electronic statement presentment (ESP) system is an enhancement, or is complimentary to any suitable electronic bill payment system. In one specific embodiment, the ESP system is an enhancement to the electronic bill payment system described in U.S. Pat. No. 5,465,206, and in particular may be integrated with VISA's ePay system to provide full-circle electronic

financial transactions for billers and consumers. By introducing electronic statement presentment to an existing electronic bill payment system, an added dimension enables fully automated bill payment. *Kolling, Col. 4, Lines 30-41.*

A bank or other consumer service provider may also integrate such an electronic statement delivery from a biller into its own electronic home banking product in order to enhance that product and to provide more value to its consumer. In this fashion, a consumer may continue a relationship with his current bank, yet still be able to receive electronic statements from any biller from which the consumer receives a service. Alternatively, a consumer may choose any consumer service provider it desires that might provide electronic statements by way of the present invention. Thus, the present invention enhances the value of the consumer financial institution or consumer service provider in the eyes of the consumer. *Kolling, Col. 5, Lines 17-29.*

The consumer financial institution may then use any of a variety of means to transmit this electronic statement to the consumer. For example, any electronic home banking service that the consumer financial institution supports may be used to transmit the electronic statement to the consumer. Electronic means such as the Internet, telephones, video telephones, televisions, WebTV, personal digital assistants, or any other proprietary communication system may be used. *Kolling, Col. 5, Lines 42-50.*

To begin enrollment, in step 704 the CSP advertises biller availability in providing electronic statements to consumers. This advertisement may take place in any of a variety of media that the CSP uses to communicate with its customers such as over the Internet, electronic mail, regular mail, telephone, newspaper advertisements, etc. *Kolling, Col. 26, Lines 25-30.*

As shown in the above excerpted portions, however, Kolling merely describes integrating “the electronic statement presentment (ESP) system” with an “electronic bill payment system”. Neither the above excerpted portions of Kolling, nor elsewhere in the Kolling reference, is there disclosure for users and non-users as recited in Claim

1. Rather, Kolling describes that each user is enrolled in the system. *See Kolling, FIG. 8 and accompanying discussion at Col. 27, Lines 37-55.*

Further, Claim 1 recites “wherein the amount of bill data included in the email message is based, at least in part, on an email address of a recipient”. The Examiner asserted the following portions of Kolling in rejecting this recited feature, which are excerpted as follows:

A CFI associated with each SGEN delivers each electronic statement to the appropriate customer using a customer identifier in the statement data and uses any chosen medium. *Kolling, Abstract.*

Whereas billers currently use an invoicing system to print statements on paper for mailing, the present invention is able to retrieve electronic statement data from invoicing system 204 for eventual generation of an electronic statement. Statement data 206 sent to biller 102 includes all of the data normally found in an invoice or a statement for a particular consumer. In one specific embodiment, statement data 206 is transmitted in the form of a statement augmented record (SAR) when the data is sent from biller 102 to SORG 208 and includes the identifier and version of the template that the biller wishes to use in preparing an electronic statement for its customers. Typically, a biller will send a batch or billing round of statement data for numerous customers all at once, although statement data 206 may be sent for a single customer as well.

Template authoring workstation (TAWS) 210 is a computer that may be physically located at, or operated by, the biller, the BSP or the BFI. TAWS 210 utilizes current off-the-shelf authoring software packages and software described herein to create templates that contain the biller's processing instructions for displaying statements and invoices. A template contains the programmed instructions and graphic pattern for statement information to be presented to the consumer and is described in more detail below in FIG. 5. *Kolling, Col. 9, Lines 34-55.*

Although the above excerpted portions describe “generation of an electronic

statement”, Kolling does not disclose “the amount of bill data included in the email message is based, at least in part, on an email address of a recipient” as recited in Claim 1. Indeed, there is no mention whatsoever of a relationship between an email address and an amount of bill data in Kolling. Rather, the Examiner asserted that “Kolling adjusts the amount of information to fit the medium”. *See Office Action Dated January 27, 2005, Page 3.* It is respectfully submitted that this is not the recited feature.

Additionally, in the rejection of Claim 11, the Examiner asserted Kolling at Col. 33, Line 43 to Col. 44, Line 33 (essentially 11 columns of the reference) as disclosing an email server having a storage medium and financial transaction manager. The Applicant repeatedly requested that the Examiner provide a full development of where in the 11 columns of the reference (or elsewhere) an email server was described. To date, the Examiner has not done so, which is respectfully submitted to indicate that no such disclosure is included in Kolling, either explicitly or inherently.

Regardless, Kolling does not disclose the above recited feature of Claim 11. As previously described in relation to Claim 1, Kolling merely describes integrating “the electronic statement presentment (ESP) system” with an “electronic bill payment system”. Neither the above excerpted portions of Kolling, nor elsewhere in the Kolling reference, is there disclosure for the recited feature of Claim 11. Rather,

Kolling describes that each user is enrolled in the system. *See Kolling, FIG. 8 and accompanying discussion at Col. 27, Lines 37-55.*

Claim 37 recites, in part, "a financial transaction manager ... to manage access to and control assets of user accounts in response to user interaction with the user interface to enable the user to conduct financial transactions with another user or non-user of the email system, wherein the non-user of the email system has not registered for a service of the email system". The Examiner asserted the following portion of Kolling in rejecting this feature:

Although the foregoing invention has been described in some detail for purposes of clarity of understanding, it will be apparent that certain changes and modifications may be practiced within the scope of the appended claims. For instance, the invention may be integrated with any suitable electronic bill payment system. The functionality of the coordinating entity, including the functionality of the TAWS, the SORG, the switch, the SGEN, the TVAL, etc., may be distributed throughout the ESP environment, and may be implemented on separate computers or the functionality may be combined on fewer computers. In particular, the functionality of the SORG, the switch and the SGEN may be implemented centrally on a single computer, or may be implemented on separate computers. Furthermore, both the SORG and SGEN may be located remotely at a biller and CSP, respectively. Also, the central site switch may be implemented using various computers performing different aspects of the switch functionality. For example, one computer may assist with ESP system functionality, while another assists with an electronic bill payment system. In addition, any format of data from a biller can be used, and the invention is capable of producing statements in a variety of data formats, including PDF, EDI 810, HTML, etc. Furthermore, statements, invoices, account updates, bills, or information of any kind may be transmitted using the present invention from a biller to one of its customers. For presentation of the information to a customer, any of a variety of media may be used to transmit and display the information from a CSP to the customer.

Therefore, the described embodiments should be taken as illustrative and not restrictive, and the invention should not be limited to the details given herein but should be defined by the following claims and their full scope of equivalents. *Kolling, Col. 34, Lines 35-67.*

As shown in the above excerpted portion, Kolling does not disclose, teach or suggest a "user" or "non-user". Indeed, the asserted portion does not even include the word "user". Rather, the asserted portion merely describes that the system of Kolling may be implemented on separate computers and that statements may be transmitted using a variety of media. Again, as previously stated in relation to Claims 1 and 11, Kolling merely describes integrating "the electronic statement presentment (ESP) system" with an "electronic bill payment system". Neither the above excerpted portions of Kolling, nor elsewhere in the Kolling reference, is there disclosure for the recited feature of Claim 37. Rather, Kolling describes that each user is enrolled in the system. *See Kolling, FIG. 8 and accompanying discussion at Col. 27, Lines 37-55.*

Claims 2, 8 and 10 depend either directly or indirectly from Claim 1 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in Claim 1, are neither shown nor suggested in the references of record, either singly or in combination with one another.

Claims 12-36 depend either directly or indirectly from Claim 11 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in

Claim 11, are neither shown nor suggested in the references of record, either singly or in combination with one another.

Claims 38-59 depend either directly or indirectly from Claim 37 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in Claim 37, are neither shown nor suggested in the references of record, either singly or in combination with one another.

The Applicant respectfully requests the Board to overturn the Second Ground of Rejection.

Third Ground of Rejection. Claims 3, 4-6 and 9 satisfy the requirements of 35 U.S.C. § 103(a) such that these claims are not unpatentable over Kolling in view of Blossman.

As previously described, Kolling describes an electronic statement presentment system. In relation to FIG. 8 of Kolling, an embodiment is described by which a consumer enrolls in an electronic statement presentment (ESP) system, which is described in Kolling as one technique by which a consumer may subscribe to the ESP service. An available subscription is equivalent to the identification of an in-service template, and a subscription may be viewed as a unique relationship between a template identifier and a customer's biller account number (CBAN). Once a subscription has been confirmed, a billing relationship is established between a consumer and a biller. *See Kolling, Col. 25, Lines 45-54.* The biller is also a participant in the Kolling system. *See Kolling, FIG. 2 and related discussion at Col. 7, Line 25 to Col. 8, Lines 35.* Thus, Kolling requires registration before a relationship is established. Blossman does not cure the defects of Kolling, namely with regard to users and non-users.

With regard to **Claim 3**, the Examiner acknowledges that Kolling does not disclose the feature, "wherein the email message includes an address of where the bill data can be confidentially viewed if the recipient is not a participant in a secure email network". However, the Examiner then asserts Blossman (Col. 2, Lines 40-45) as disclosing this feature. The Applicant respectfully submits that the asserted section of Blossman does not teach or suggest "constructing the email message to include at least an address of where the bill data may be confidentially viewed if the recipient is a non-user of the secure email system" as recited in Claim 3. For convenience, the

asserted portion of Blossman is reproduced below.

However, the full check image of the Simmons patent is not described as a pictorial image of the actual paper check and is illustrated as a printed line of text conveying the check number, date, amount, etc. Additionally, the Simmons patent discloses the use of electronic mail for the transmission of notifications regarding potential errors.

Although the above reproduced disclosure from Blossman does mention the use of electronic mail for notifications regarding errors, it does not disclose “an address of where the bill data can be confidentially viewed ...” as recited in Claim 3. Therefore, the Applicant respectfully submits that the combination of Kolling and Blossman does not teach or suggest each and every element of Claim 3, and consequently, does not make out a *prima facie* case of obviousness for this additional reason.

The Applicant respectfully requests the Board to overturn the Third Ground of Rejection.

Fourth Ground of Rejection. Claim 7 satisfies the requirements of 35 U.S.C. § 103(a) such that these claims are not unpatentable over Kolling in view of Weatherly.

Claim 7 depends from Claim 1. As discussed above, Claim 1 is patentable over the combination of Kolling and Blossman. Cornelius is cited as disclosing, "identifying a domain name from the email address; and cross referencing the identified domain name against a list of secure domain names to determine whether the recipient belongs to a secure email network."

Applicants respectfully assert that the cited portion of Cornelius does not teach or suggest identifying a domain name from an email address. Rather, the cited portion of Cornelius appears to be directed to the firewalls shown in FIGS. 37 and 38. As can be seen in FIGS. 37 and 38, the firewalls are directed to protecting web servers and not email servers.

Further, the cited portion of Cornelius does not mention email address; instead it lists "user names and passwords, Internet IP address or domain name." There is no indication of where the domain is obtained. Moreover, the disclosure of web servers in FIGS. 37 and 38 would indicate that the domain name is obtained from web address and not an email address. Therefore, the listing of multiple security techniques does not teach or suggest identifying a domain name from an email address.

The Applicant respectfully requests the Board to overturn the Fourth Ground of Rejection.

CONCLUSION

The Applicant respectfully considers this application to be in condition for allowance and respectfully request the Board to overturn the final rejection and that the Examiner pass this application to allowance.

Dated this 15th day of July, 2005.

Respectfully submitted,



WILLIAM J. BREEN, III
Attorney for Applicant
Registration No. 45,313

LEE & HAYES PLLC
421 W. Riverside Avenue, Suite 500
Spokane, WA 99201
Telephone: (509) 324-9256 (Ext. 249)
Facsimile: (509) 323-8979

APPENDIX: CLAIMS ON APPEAL

Listing of Claims:

1. A method comprising:

receiving bill data; and

generating an email message with information including at least a portion of the received bill data, wherein the amount of bill data included in the email message is based, at least in part, on an email address of a recipient, and wherein the recipient can be either a user or a non-user of a secure email system, wherein no non-user had registered for a service of the secure email system.

2. A method according to claim 1, further comprising:

sending the email message to the recipient.

3. A method according to claim 1, wherein the step of generating comprises:

determining whether the recipient is a participant in a secure email network; and

constructing the email message to include at least an address of where the bill data may be confidentially viewed if the recipient is a non-user of the secure email network.

4. A method according to claim 3, further comprising:

constructing the email message to include substantially all of the bill data along with

financial Multipurpose Internet Multimedia Extensions (MIME) elements which enable the recipient to manage a financial account.

5. A method according to claim 4, wherein the MIME elements enable the recipient to pay all or part of the received bill.

6. A method according to claim 4, wherein the MIME elements enable the recipient to establish and manage a financial account.

7. A method according to claim 3, wherein the step of determining comprises:
identifying a domain name from the email address; and
cross referencing the identified domain name against a list of secure domain names to determine whether the recipient belongs to a secure email network.

8. A method according to claim 1, further comprising:
receiving the sent email message including at least a portion of the bill data at the recipients email address; and
displaying at least a portion of the message in an inbox of an email client used by the recipient to access their email account.

9. A method according to claim 8, further comprising:

displaying the email message in the email client of the recipient, upon user access of the email message, wherein the email message includes financial Multipurpose Internet Mail Extension (MIME) elements that enable the recipient to pay some or all of the received bill.

10. A method according to claim 8, further comprising:

paying some or all of the received bill by responding to the email

11. A data network comprising:

a plurality of computing devices, coupled to the network, to facilitate network access by one or more participants; and

an email server, coupled to the data network and responsive to one or more of the plurality of computing devices, the data server including:

a storage medium to store at least one financial account for each of the plurality of participants; and

a financial transaction manager, coupled to the memory device and selectively invoked by a participant, to manage access to and manipulation of financial account assets to effect requested financial transactions with any network participant or non-participant, wherein no non-participants have registered for a service of an email

system supported by the email server.

12. A data network according to claim 11, wherein the financial account is electronically linked to an account of the participant at a financial institution.

13. A data network according to claim 12, wherein the account of the participant is one of a checking account, a savings account, a line of credit, and a money market account maintained by a banking institution.

14. A data network according to claim 11, wherein the financial account is one of a checking account, a savings account, a line of credit, and a money market account maintained by a banking institution.

15. A data network according to claim 11, wherein the computing devices are one or more of a personal computer, a personal digital assistant, a kiosk, a telephone and a set-top box having sufficient resources to enable the participant to access the data server and utilize the financial transaction manager.

16. A data network according to claim 11, further comprising an email system having a plurality of data servers including the data server.

17. A data network according to claim 11, wherein the data server is controlled by a financial institution.

18. A data network according to claim 11, wherein the financial transaction manager selectively transfers assets from a first participant's account to a second participant's account in response to a request by the first participant to transfer such assets.

19. A data network according to claim 18, wherein each of the first and second participants are individual consumers, a business, or a combination of each.

20. A data network according to claim 18, wherein the first participant does not have a priori knowledge of the second participant's account information, but identifies the second participant from a list of network participants.

21. A data network according to claim 20, wherein the second participant is identified by one of a name, an alias, or an email address.

22. A data network according to claim 11, wherein the financial transaction manager selectively receives assets for deposit in an account of a participant.

23. A data network according to claim 22, wherein the assets are received from a brokerage at the request of the participant.

24. A data network according to claim 22, wherein the assets are received from an employer as compensation to the participant.

25. A data network according to claim 11, wherein the financial transaction manager prompts a participant for payment authorization in response to a request for payment received from a network service.

26. A data network according to claim 25, wherein the network service is an electronic auction service.

27. A data network according to claim 25, wherein the network service is an electronic retail service.

28. A data network according to claim 25, wherein the financial transaction

manager transfers assets from an account specified by the user to an account specified in the request to cover the requested payment, upon authorization of the participant.

29. A data network according to claim 28, wherein the financial transaction manager determines whether to honor the participants payment when the specified account has insufficient assets to cover the requested payment.

30. A data network according to claim 29, wherein the financial transaction manager utilizes a growing trust model to determine whether to honor the payment when the specified account has insufficient assets to cover the requested payment.

31. A data network according to claim 29, wherein the financial transaction manager automatically accesses a line of credit associated with the participant to honor the payment when the specified account has insufficient assets to cover the requested payment.

32. A data network according to claim 31, wherein the financial transaction manager notifies the participant of the insufficient funds and that the line of credit has been accessed to honor the requested payment.

33. A data network according to claim 25, wherein the financial transaction

manager issues an instruction to have a check issued and sent to an address specified by the request, upon authorization of the participant.

34. A data network according to claim 33, wherein the issued check includes a uniform resource locator (URL) address of a web page offered by the data server where the recipient can establish an account.

35. A data network according to claim 34, wherein the check includes an offer of free assets, credited to a newly established account created by the recipient of the check.

36. A storage medium having stored thereon a plurality of executable instructions which, when executed, implement a financial transaction manager according to claim 11.

37. An email system, selectively accessed by users on a data network using a computing device, the email system comprising:

a user interface, through which a user accesses an account associated with the user;
one or more storage devices, to store and maintain account information for each of the users; and

a financial transaction manager, responsive to the user interface and coupled to the one or more storage devices, to manage access to and control assets of user accounts in

response to user interaction with the user interface to enable the user to conduct financial transactions with another user or non-user of the email system, wherein the non-user of the email system has not registered for a service of the email system.

38. An email system according to claim 37, wherein the user interface is series of instructions issued to a computing device of the user to create a web page at the computing device.

39. An email system according to claim 37, wherein the user interface is a series of instructions issued to an email client executing on a computing device of the participant.

40. An email system according to claim 37, wherein the financial transaction manager selectively transfers assets from a first user's account to a second user's account in response to a request by the first user to transfer such assets.

41. An email system according to claim 37, wherein the financial transaction manager causes a check to be printed and sent to another at the request of a user.

42. An email system according to claim 41, wherein the check includes an offer to create an account at the email system.

43. An email system according to claim 40, wherein each of the first and second users are individual consumers, or businesses.

44. An email system according to claim 40, wherein the first user does not have a priori knowledge of the second user's account information, but identifies the second participant from a list of network participants provided by the financial transaction manager.

45. An email system according to claim 40, wherein the second user is identified by one or more of the user's name, alias, or email address.

46. An email system according to claim 37, wherein the financial transaction manager selectively receives assets for deposit in an account of a participant.

47. An email system according to claim 46, wherein the assets are received from a brokerage at the request of the participant.

48. An email system according to claim 46, wherein the assets are received from an

employer as compensation to the participant.

49. An email system according to claim 37, wherein the financial transaction manager prompts a participant for payment authorization in response to a request for payment received from a network service.

50. An email system according to claim 49, wherein the network service is an electronic auction service.

51. An email system according to claim 49, wherein the network service is an electronic retail service.

52. An email system according to claim 49, wherein the financial transaction manager transfers assets from an account specified by the user to an account specified in the request to cover the requested payment, upon authorization of the participant.

53. An email system according to claim 52, wherein the financial transaction manager determines whether to honor the participants payment when the specified account has insufficient assets to cover the requested payment.

54. An email system according to claim 52, wherein the financial transaction manager utilizes a growing trust model to determine whether to honor the payment when the specified account has insufficient assets to cover the requested payment.

55. An email system according to claim 52, wherein the financial transaction manager automatically accesses a line of credit associated with the participant to honor the payment when the specified account has insufficient assets to cover the requested payment.

56. An email system according to claim 25, wherein the financial transaction manager issues an instruction to have a check issued and sent to an address specified by the request, upon authorization of the participant.

57. An email system according to claim 33, wherein the issued check includes a uniform resource locator (URL) address of a web page offered by the data server where the recipient can establish an account.

58. An email system according to claim 34, wherein the check includes an offer of free assets, credited to a newly established account created by the recipient of the check.

59. A storage medium having stored thereon a plurality of executable instructions

which, when executed, implement an email system according to claim 37.